UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,080	03/31/2004	Wallace Lynn Smith	MacBride86067-001	5650

7590 02/23/2006

William L. MacBride, Jr.
33 South Last Chance Gulch
Helena, MT 59601

EXAMINER	
ASTORINO, MICHAEL C	
ART UNIT	**PAPER NUMBER**
3736	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

e

Office Action Summary	Application No.	Applicant(s)	
	10/813,080	SMITH, WALLACE LYNN	
	Examiner	Art Unit	
	Michael C. Astorino	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The examiner acknowledges the amendment filed November 16, 2005.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter since the claimed invention is a manipulation of abstract ideas, does not have a practical application and fails to achieve a useful, concrete, and tangible result. The applicant is directed to the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility at, http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm

Practical Application

Claim fails to physically transform an article or physical object to a different state or thing.

Useful Result

The claimed invention must be (i) specific (ii) substantial and (iii) credible. The claimed invention appears to the examiner to be specific and substantial, and credible.

Concrete Result

The method of diagnosing a probability of pain relief through medical treatment in a patient does not produce concrete, substantially repeatable results. Otherwise stated, it is extremely unlikely that two separate people with the same actual probability of pain relief through medical treatment will answer the same questions the same way to produce the same

outcome; or, the same patient will respond to the same questions with the same answers to produce the same results. In either case, the method is not substantially repeatable.

Tangible Result

The claimed invention does not produce a "tangible" result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). A method of diagnosing a probability of pain relief through medical treatment in a patient and the steps claimed is no more than a manipulation of an abstract idea.

In this case, the method comprises, according to claim 1, steps 1(a)-(u). The steps include administering a perceptual test, receiving responses, providing, determining and applying scoring templates, etcetera, until values are summed to produce a pain index score. These steps are not a tangible entities having substance.

In conclusion, the applicant's the claimed invention recites a manipulation of an abstract idea that lacks a practical application and does not produce a useful, concrete and tangible result.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention without undue experimentation since the claimed invention lacks of substantially repeatability.

Response to Arguments

Applicant's arguments filed November 16, 2005 have been fully considered but they are not persuasive.

35 U.S.C. 101

The applicant has made several assertions and argues several points the examiner mostly disagrees with. Those points the examiner agrees with do not overcome the 35 U.S.C. 101 rejection.

Page 7, lines 5-7, the applicant states, "The invention ... leaves the public domain and enter the concrete world of the artificial domain when the analysis is recorded." The claims do not state the analysis is ever recorded.

Page 7, lines 7-9, "...the recited steps themselves involve manipulation of abstract ideas they are affected by an artificial (man-made) agency, thereby making the subject matter statutory." The examiner disagrees. Even though many of the steps include manipulation of abstract ideas, it does not make the claim have statutory subject matter.

Page 7, lines 17-19, "Until set down in the Paindex® outcome analysis, the patient responses were in the abstract domain. The Pain Index Score and the Paindex Outcome® gave substance to the analysis, as recognized by the industry." First, the examiner agrees with the applicant that the patient responses were in the abstract domain. Secondly, the Paindex® outcome analysis is not claimed. Next, although Pain Index Score is claimed it is not statutory for the same reason as the whole claim is not statutory under 101 - it fails to produce a "useful, concrete and tangible result."

Page 8, line 17, the applicant states, "the invention does not claim the underlying mathematical algorithms..." the examiner agrees with this assertion.

Page 9, line 10, the applicant states that "the claims recite several recording steps..." but the claims never recite a recording step.

Page 9, line 11, the applicant states "the process of writing down" The claims never recite anything being written down.

Page 10, lines 17-18, "The office action asserts that the method of diagnosing a probability does not produce substantially repeatable results." This is accurate. Concreteness, otherwise stated, a substantially repeatable result is not met by the claimed invention. The applicant afterwards made numerous assertions having very little to do with concreteness or having a substantially repeatable results. Specifically, self proclaimed success (page 10, lines 18-19), nor statements of notations by other experts regarding prior work are sufficient to meet the standard. Especially since the applicant himself states later on the same page that applicant has failed in some aspect in his previous work to accurately predict the probability of pain relief. Additionally, the applicant's assertions of predictability without any evidence in support thereof

fails to provide enough evidence to meet the concreteness standard. The examiner invites the applicant to provide actual evidence that proves the assertions and conclusions that are made by the applicant. Additionally, undue experimentation is not a factor in the concreteness standard.

See also, Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility at, http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm

112

The applicant's arguments are not persuasive. The examiner maintains his rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Astorino whose telephone number is 571-272-4723. The examiner can normally be reached on Monday-Friday, 8:30AM to 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Astorino
February 20, 2006